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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,417	03/05/2001	Satoshi Kanatani	60302-300301	2559

7590 03/30/2004

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EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 03/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,417

Applicant(s)

KANATANI, SATOSHI

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-63 have been examined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claim 1, 2, 3, 5, 11, 12, 13, 15, 21, 22, 23, 25, and 55-60 are rejected under 35 U.S.C. 102(e) as being unpatentable over Thomas (6,128,663).

Claim 1, 11, 21: Thomas discloses a method, program, system for generating revenue utilizing a network comprising: displaying indicia on a computer terminal utilizing a network (col 5, lines 15-29); receiving an indication upon the selection of the indicia by a user at the computer terminal utilizing the network (col 5, lines 15-29); prompting the entry of information relating to the user utilizing the network upon the receipt of the indication (col 5, lines 30-37; col 4, lines 21-30; col 6, lines 56-61);

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receiving the information relating to the user (col 5, lines 37-42);
storing the information relating to the user in a database (col 10, lines 1-7; col 4, lines 21-30); and
executing a raffle function utilizing the information stored in the database (col 10, lines 5-15;
Fig. 5).

Claim 2, 12, 22: Thomas discloses a method as recited in claim 1, wherein the indicia includes a banner (Fig. 1; col 5, lines 14-17; col 1, lines 39-41; Fig. 7).

Claim 3, 13, 23: Thomas discloses a method as recited in claim 1. Thomas further discloses that the indicia includes an icon on a banner (Fig. 7; col 10, lines 44-52).

Claim 5, 15, 25: Thomas discloses a method as recited in claim 1, wherein the entry of information is prompted on a page on the network separate from that on which the indicia is located (col 6, lines 56-61).

Claim 55, 56, 57, 58, 59, 60: Thomas discloses a method, program, system for generating revenue utilizing a network comprising: displaying an indicia separate from a banner on a computer terminal from a first site utilizing a network (Fig. 1; Fig. 7; Fig. 11);
receiving an indication upon the selection of the indicia separate from the banner by a user at the computer terminal utilizing the network (col 5, lines 20-28); linking to a distributing server upon receipt of the indication that the indicia is selected (col 5, lines 45-56); and

linking to one of several client sites by the distributing server (col 5, lines 45-56).

Thomas further discloses prompting the entry of information relating to the user at the distribution server (col 5, lines 30-37; col 4, lines 21-30; col 6, lines 56-61);
linking to one of several impact sites by the distributing server based upon the information submitted by the user (col 10, lines 5-14); and

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linking to a client site after the user is done viewing the impact site (col 5, lines 45-56).

Thomas further discloses linking to a raffle server upon receipt of the indication that the indicia is selected (col 10, lines 1-14).

Note that distributing server, impact site, client site are loosely defined in the claim and, therefore, open to broad claims interpretation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 4, 6-10, 14, 16-20, 24, 26-30, 31-54, 61-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (6,128,663).

Claim 4, 6, 10, 14, 16, 20, 24, 26, 30: Thomas discloses a method as recited in claim 1.

Thomas further discloses a banner with indicia that leads to a separate page on a network for attempting to receive a prize (Fig. 7, 'Celebrate and Win. Click Here').

Thomas further discloses a separate page on a network where a user can select an indicia and enter demographic information and attempt to receive and incentive (Fig. 1).

Thomas does not explicitly disclose that the banner of Fig. 7 can lead to the incentive fulfillment pages of Fig. 1.

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However, Thomas discloses multiple advertisers (col 1, lines 25-33) and different sites on the network (Fig. 11 represents the Yahoo site and a link to the Music Connection site). Also, different advertisers implies that there are different banner advertisements that offer links to different sites.

Thomas further discloses that a page with banner advertisements can lead to other pages with banner advertisements (col 5, lines 48-56; Fig. 11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Thomas banner on a separate site to Thomas page with banner that leads to indicia for a entering for a prize. One would have been motivated to do this in order to utilize banner advertisements to better attract users attention and encourage the utilization of banner advertisement for linking users to different websites represented by advertisers.

Claim 7, 17, 27: Thomas discloses a method as recited in claim 6, and Thomas further discloses the second indicia is advertisement indicia (Fig. 7; Fig. 11; Fig. 1).

Claim 8, 18, 28: Thomas discloses a method as recited in claim 6, and Thomas further discloses linking to the separate site on the network after receiving the information relating to the user (col 5, lines 45-56).

Claim 9, 19, 29: Thomas discloses a method as recited in claim 8, and Thomas further discloses that the separate site on the network is linked to upon the selection of a link indicia (Fig. 11).

Claim 31, 33, 35, 37, 39, 41, 43, 45, 47, 49, 51, 53: Thomas discloses a method, medium, system for generating revenue utilizing a network comprising:

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displaying first indicia and second indicia at a first page of a first site utilizing a network (Fig. 1, Fig. 7, Fig. 11).

Thomas further discloses receiving an indication at the first site on the network upon the selection of either the first indicia or the second indicia by a user at a computer terminal coupled to the first site utilizing the network (Fig. 1);

prompting the entry of information relating to the user at a second page of the first site upon the receipt of the indication that the first indicia is selected, the information relating to the user being received and stored in a database for executing a function (col 5, lines 30-37; col 4, lines 21-30; col 6, lines 56-61);

displaying link indicia at the second page of the first site utilizing the network upon the receipt of the indication that the first indicia is selected, the link indicia adapted for linking to a third site on the network (Fig. 1, Fig. 7, Fig. 11); and

linking to the third site on the network upon the receipt of the indication that the second indicia is selected (Fig. 1, Fig. 7, Fig. 11; col 5, lines 45-56).

Thomas further discloses a banner with indicia that leads to a separate page on a network for attempting to receive a prize (Fig. 7, 'Celebrate and Win. Click Here').

Thomas further discloses a separate page on a network where a user can select an indicia and enter demographic information and attempt to receive an incentive (Fig. 1).

Thomas does not explicitly disclose that the banner of Fig. 7 can lead to the incentive fulfillment pages of Fig. 1.

However, Thomas discloses multiple advertisers (col 1, lines 25-33) and different sites on the network (Fig. 11 represents the Yahoo site and a link to the Music Connection site). Also,

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different advertisers implies that there are different banner advertisements that offer links to different sites.

Thomas further discloses that a page with banner advertisements can lead to other pages with banner advertisements (col 5, lines 48-56; Fig. 11).

Furthermore, the obvious relations and combinations of Fig. 1, Fig. 7, Fig. 11 yields the same site (if one stays within the Yahoo site) or multiple sites (if one goes between sites such as Yahoo and Music Connection). It further yields multiple indicia and icons as shown in Fig. 1, Fig. 7, Fig. 11. It further yields historic operation of sites as demonstrated in (col 5, lines 45-56) where it is shown that demographic information can be collected for utilization with further or subsequent navigations. Furthermore, Thomas discloses flexibility as to when the demographics information can be collected (coil 6, lines 50-61) and Thomas discloses flexibility in that an incentive or raffle can be offered anytime further demographics information is desires (col 10, lines 4-14).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Thomas banner on a separate site to Thomas page with banner that leads to indicia for a entering for a prize. One would have been motivated to do this in order to utilize banner advertisements to better attract users attention and encourage the utilization of banner advertisement for linking users to different websites represented by advertisers.

Claim 32, 34, 36, 38, 40, 42, 44, 46, 48, 50, 52, 54: Thomas discloses a method as recited in claim 32, wherein the indicia includes raffle indicia, and the function is a raffle function (col 10, lines 5-15).

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Claim 61, 62, 63: Thomas discloses a method, program, system for generating revenue utilizing a network comprising: displaying an indicia separate from a banner on a computer terminal from a first site utilizing a network (Fig. 1; Fig. 7; Fig. 11); receiving an indication upon the selection of the indicia separate from the banner by a user at the computer terminal utilizing the network (col 5, lines 20-28); linking to a distributing server upon receipt of the indication that the indicia is selected (col 5, lines 45-56); and

linking to one of several client sites by the distributing server (col 5, lines 45-56).

Thomas further discloses prompting the entry of information relating to the user at the distribution server (col 5, lines 30-37; col 4, lines 21-30; col 6, lines 56-61); linking to one of several impact sites by the distributing server based upon the information submitted by the user (col 10, lines 5-14); and

linking to a client site after the user is done viewing the impact site (col 5, lines 45-56).

Thomas further discloses linking to a raffle server upon receipt of the indication that the indicia is selected (col 10, lines 1-14).

Thomas does not explicitly disclose linking to a distributing server upon receipt of the indication that the user did or did not participate in a raffle.

However, Thomas further discloses the user participating in a raffle (col 10, lines 1-12) and linking to a distributing server (col 11, lines 16-24).

Thomas further discloses tracking user interaction (col 6, lines 23-27) and passing that information to websites or servers (col 12, lines 16-25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Thomas participation in a raffle information to Thomas

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demographic information passed to a server or website. One would have been motivated to do this in order to provide further demographic information about a user.

Note that distributing server, impact site, client site are loosely defined in the claim and, therefore, open to broad interpretation.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. Eggleston (6,061,660) discloses sweepstakes as incentives for user interaction with a site and the recording of demographic information;
- b. Auxier (6,379,251) discloses incentives for user interaction with a site;
- c. Miles (6,102,406) discloses incentives for user interaction with a site;
- d. De Rafael (6,529,878) discloses incentives for user interaction with a site and recording of user information.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9326.

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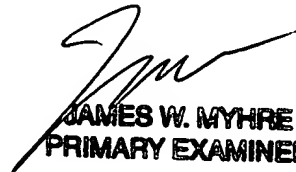
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

Ad

12/15/03


JAMES W. MYHRE
PRIMARY EXAMINER